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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte D. AMNON SILVERSTEIN

Appeal 2007-4438
Application 09/843,755
Technology Center 2100

Decided: March 31, 2008

Before JAMES D. THOMAS, LANCE LEONARD BARRY, and
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1-3 and 5-17. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

A. INVENTION

1 The invention at issue involves using a display device as a moveable user interface (Spec. 1). In particular, a moveable display is moved over a surface. The movement of the display is tracked and an image is displayed on the display based on the tracked movement of the display (*id.* 2).

B. ILLUSTRATIVE CLAIM

Claim 10, which further illustrates the invention, follows:

10. Method for displaying information related to a physical document, comprising:

- detecting movement of a movable display relative to a first surface;
- correlating movement of the movable display to information representing a portion of a first image stored in a database; and
- presenting the information on the movable display, wherein the detecting includes detecting orientation of the movable display.

C. REJECTIONS

Claims 1-3 and 5-15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,714,972 (“Tanaka”). Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanaka and U.S. Patent No. 6,501,464 (“Cobbley”). Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanaka and U.S. Patent No. 6,359,615 (“Singh”).

II. CLAIM GROUPING

1 “When multiple claims subject to the same ground of rejection are argued as a group by the appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of the appellant to separately argue claims which the appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.” 37 C.F.R. § 41.37(c)(1)(vii) (2006).¹

Appellant argues claims 1 and 10 as a group² (App. Br. 5-7) and claims 16 and 17 separately.

We select claim 10 as the sole claim on which to decide the appeal of the group. Claims 2, 3, 5-9, and 11-15 are not argued separately and will stand or fall with independent claim 10. We decide the appeal of claims 16 and 17 separately.

III. CLAIMS 1-3 AND 5-15

As set forth above, we select claim 10 as the sole claim on which to decide the appeal of the first group. “Rather than reiterate the positions of

¹ We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief. The current version includes the same rules.

² Appellant relies on the same arguments for claim 10 as applied against claim 1.

parties *in toto*, we focus on the issue therebetween.” *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at *2 (BPAI 2007).

Appellant asserts that “[t]he Tanaka patent clearly does not teach detecting orientation of a movable display” because “[t]he ability to detect ‘orientation’ encompasses an ability to detect rotation of the display, a feature which is not disclosed by the Tanaka patent” (App. Br. 6).

The Examiner finds that “detecting orientation” is not limited to “detecting rotation” (Ans. 8). “[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000). Here, we conclude the Examiner has properly construed the claim term “orientation” in accordance with the broadest reasonable interpretation consistent with the Specification. When we look to Appellants’ Specification, we find no express definition of the claim term “orientation.” Thus, Appellants’ Specification fails to set forth a definition of the term with “reasonable, clarity, deliberateness, and precision” that would render the incorporation of such a definition into the claims appropriate (*quoting In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994)).

In the absence of an explicit definition of the term “orientation” in the Specification, we construe the term “orientation” using a reasonably broad, plain and ordinary definition of “the position or direction in which something lies or the proper positioning or state of parts in relation to each other.” *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1373 (Fed.

Cir. 2004) (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say).

Tanaka discloses “a position sensor, a velocity sensor, an acceleration sensor or the like” (col. 3, ll. 48-50) that “detects the position (of a display screen) in the horizontal and vertical directions” (col. 3, ll. 53-55). We find that detecting the position of a display screen in horizontal and vertical directions (Tanaka) encompasses detecting the position or direction in which something lies or the proper positioning or state of parts in relation to each other (i.e., “detecting orientation”).

Appellants assert that detecting orientation “encompasses an ability to detect rotation” but have not demonstrated that the term “orientation,” interpreted reasonably broadly, must include “rotation” of a display screen. The Specification fails to expressly define “orientation” as including “rotation.” Nor has Appellant provided extrinsic evidence demonstrating that one of ordinary skill in the art would have interpreted “orientation” as including only “rotation” of the display screen. Therefore, we decline to adopt this limited definition of “orientation.”

In addition, the Examiner finds that the instant Specification discloses that detecting orientation of a display screen is accomplished by “tracking enough positional coordinates of the movable display 100 relative to the surface 104” (Spec. 6). Tanaka discloses a “position sensor” that “detects the position in the horizontal and vertical directions” (col. 3, ll. 46-55). We

find that the detecting performed by the position sensor of Tanaka encompasses “tracking enough positional coordinates” of the display, which provides for detecting “orientation of the display relative to the surface” (Spec. 6).

It follows that Appellant has failed to demonstrate that the Examiner erred in rejecting claim 10. Therefore, we affirm the rejection of claim 10 and of claim 1, which falls therewith. Claims 2, 3, 5-9, and 11-15, not separately argued by Appellant, also fall therewith.

IV. CLAIM 16

Appellant argues that “there is no teaching or suggestion in (Cobbley) for correlating movement of the display 500 to information representing a portion of a first image, where the first image is the image of keyboard interface 508” (App. Br. 7).

The Examiner finds that claim 16 is unpatentable over the combination of Tanaka and Cobbley, rather than over the Cobbley reference in isolation. Therefore, even assuming that Cobbley fails to disclose correlating movement of a display to information of an image of a keyboard as Appellant asserts, Appellant has nevertheless failed to demonstrate that the combination of Tanaka and Cobbley fail to disclose the disputed features of claim 16. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

In re Keller, 642 F.2d 413 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 1986).

The Examiner finds that Tanaka discloses “a position detector . . . for detecting position in horizontal and vertical directions” (Ans. 9). Based on the detected position of the display screen, the display screen “supplies the selected image information to the display screen 4” such that “when the position of the display screen 4 is changed, the selector 3 updates the selected image information” (Tanaka, col. 4, ll. 2-5). We agree with the Examiner that displaying selected image information on a display screen based on the detected position of the screen (Tanaka) encompasses correlating movement of a display to information of an image as recited in claim 16.

There are a finite number of known image types that may be displayed on a display. The Examiner finds that Cobbley discloses one such known image type that may be displayed on a display device as including an image of a keyboard. Displaying an image of a keyboard would have produced expectedly predictable results as demonstrated by Cobbley (i.e., the display of an image of keyboard on a display). Such anticipated success of using known methods to achieve expected results would be obvious to one of ordinary skill in the art.

“When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated

success, it is likely the product not of innovation but of ordinary skill and common sense.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007).

Appellant further argues that “there would have been no motivation or suggestion to have combined features of the Tanaka patent with features of the Cobbley patent” because Cobbley “is not directed to displaying information related to a physical document, in which information representing a portion of a first image is presented on a movable display” (App. Br. 7). As set forth above, Tanaka discloses displaying an image based on position of a display screen while Cobbley discloses a specific type of image that can be displayed on a display (i.e., an image of a keyboard). We agree with the Examiner that it would have been obvious to one of ordinary skill in the art to combine Tanaka and Cobbley because the combination represents no more than the arrangement of familiar elements that yield predictable results. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. . . . [W]hen a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR* at 1395-66 (citing *Sakraid v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976)).

It follows that Appellant has failed to demonstrate that the Examiner erred in rejecting claim 16.

V. CLAIM 17

Appellant does not argue patentability of claim 17 but argues with regard to claim 16 that “[t]he Singh patent does not overcome the deficiencies of the Tanaka and Cobbley patents” (App. Br. 8). The Examiner does not apply Singh to claim 16 but, rather, applies the Singh reference to claim 17. To the extent that Appellant intends to refer to claim 17, Appellant nevertheless fails to establish any specific deficiencies in Tanaka or the combination of Tanaka and Singh with regard to claim 17.

It follows that Appellant has failed to demonstrate that the Examiner erred in rejecting claim 17.

VI. ORDER

In summary, the rejection of claims 1-3 and 5-17 under § 103(a) is affirmed.

Appeal 2007-4438
Application 09/843,755

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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